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Dated: March 9 2007 Signature:

Docket No.: 19036/40796

(PATENT)

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Yuka Matsui

Application No.: 10/561,629

Confirmation No.: 8420

Filed: June 21, 2004 as PCT/JP2004/008710 (national

stage entry on December 20, 2005)

Art Unit: Not Yet Assigned

For: OPHTHALMIC COMPOSITION

Examiner: Not Yet Assigned

# PETITION UNDER 37 CFR §1.182

Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450

Dear Sir:

## **Relief Requested**

Assignee respectfully requests that the U.S. Patent and Trademark Office substitute the attached Declaration of Facts of Ms. Makoda Yamashita and its corresponding Exhibits A-F (redacted) for the similar documents that were filed on February 2, 2007 with a Petition Under 37 CFR §1.47(b). A check in the amount of \$400, as required by 37 CFR §§1.17(f) and 1.182, is also enclosed. The Director is authorized to charge any deficiency in fees paid to Deposit Account No. 13-2855, under Order No. 19036/40796.

## **Explanation of Facts to Support Relief Requested**

The inventor for this application, Yuka Matsui, has changed jobs and has refused to sign an inventor's declaration or cooperate with her former employer, the assignee of this application. On February 2, 2007, a petition to accept the filing of the application under 37 CFR §1.47(b) was filed. However, Ms. Matsui refused to permit the assignee to provide her address for the petition under 37 CFR §1.47(b).

According to a recent Japanese privacy law, the assignee is barred from supplying any personal information about Ms. Matsui, including email and mailing addresses, without her consent. A petition to suspend the ruled was filed to explain these circumstances. The evidence in support of the Petition under 37 CFR §1.47(b) included exhibits that contain personal information and should properly have been redacted. The replacement Exhibits A-F, filed herewith, have been redacted to remove all private information for inventor Matsui. The information relevant to the petition under 37 CFR §1.47(b) has not been redacted. In deference to the Japanese privacy law, the assignee requests that the Patent Office accept substitution of these replacement Exhibits A-F and destroy the originally submitted Exhibits A-F. If the original documents have been stored electronically, the assignee requests that the electronic versions be destroyed as well, so that they do not appear in any electronic file wrapper, now or in the future.

Also enclosed with this Petition is a copy of a duly executed Statement under 37 CFR 3.73(b), signed by the assignee. The undersigned attorney represents the assignee in this matter.

If the Patent Office or Petitions Officer wishes to discuss this request further, s/he is invited to contact the undersigned at the telephone number listed below.

Dated: March 9 2007

Respectfully submitted,

David A. Gass

Registration No.: 38,153

MARSHALL, GERSTEIN & BORUN LLP

233 S. Wacker Drive, Suite 6300

Sears Tower

Chicago, Illinois 60606-6357

(312) 474-6300

Attorney for Assignee

PTO/SR/96 (09-06) Approved for use through 03/31/2007. OMB 0651-0031 U.S. Pateni and Trademark Office; U.S. DEPARTMENT OF COMMERCE

81-72-640-0122

Telephone Number

81-72-641-7840

Facsimile Number

#### are required to respond to a collection of information unless it displays a valid OMB control number. STATEMENT UNDER 37 CFR 3.73(b) Applicant/Patent Owner: Yuka Matsui Application NoJPatent No.: 10/561,629 Filed/Issue Date: December 20, 2005 Entitled: OPHTHALMIC COMPOSITION KOBAYASHI PHARMACEUTICAL CO. LTD. Corporation (Name of Assigner) (Type of Assignae, e.g., corporation, partnarship, university, government agency, etc.) states that it is: x the assignee of the entire right, title, and interest; or an assignee of less than the entire right, title and interest. (The extent (by percentage) of its ownership interest is In the patent application/patent identified above by virtue of either: x An assignment from the inventor(s) of the patent application/patent identified above. The assignment was recorded in the United States Patent and Trademark Office at Resi 018674 0470 , or a true copy of the original assignment is attached. OR A chain of title from the inventor(s), of the patent application/patent identified above, to the current В. assignee as follows: 1. From: The document was recorded in the United States Patent and Trademark Office at , Frame , or for which a copy thereof is attached. The document was recorded in the United States Patent and Trademark Office at . Frame , or for which a copy thereof is attached. To: The document was recorded in the United States Patent and Trademark Office at , Frame \_, or for which a copy thereof is attached. Additional documents in the chain of title are listed on a supplemental sheet. As required by 37 CFR 3.73(b)(1)(i), the documentary evidence of the chain of title from the original owner to the assignce was, or concurrently is being, submitted for recordation pursuant to 37 CFR 3.11. [NOTE: A separate copy (i.e., a true copy of the original assignment document(s)) must be submitted to Assignment Division in accordance with 37 CFR Part 3, to record the assignment in the records of the USPTO. See MPEP 302.08] The undersigned (whose title is supplied below) (sauthorized to act on behalf of the assignee. February 1, 2007 dhature Date Yutaka KOBAYASHI

Printed or Typed Name

President & COO

Title

OIPE 4208 MAR 16 2007

hereby certify that this paper (along with any paper referred to as being attached or enclosed) to being deposited with \$50.5. Postal Service on the date shown pelow with sufficient postage as \$50.00 Class Mail, in an envelope addressed to:

Commissioner for \$22313-1450.

Dated: Feb 2, 7007 Signature:

Del a Gress

Docket No.: 19036/40796

(PATENT)

# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of: Yuka Matsui

Application No.: 10/561,629

Confirmation No.: 8420

Filed: June 21, 2004 as PCT/JP2004/008710 (national

stage entry on December 20, 2005)

Art Unit: Not Yet Assigned

For: OPHTHALMIC COMPOSITION

Examiner: Not Yet Assigned

# DECLARATION OF FACTS FOR PETITION TO ACCEPT FILING UNDER 37 CFR §1.47(b)

Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450

Dear Sir:

# I, Madoka Yamashita, hereby declare as follows:

- 1. I am a Senior Staff member of Kobayashi Pharmaceutical Co., Ltd., assignee of the above-identified application (hereafter "Assignee"). I submit this Declaration for the purpose of setting out facts relating to the refusal of Yuka Matsui, sole inventor of the subject matter in the above-identified patent application, to execute a Declaration.
- 2. On June 20, 2003, Japanese Patent Application No. 2003-176965 was filed, naming Ms. Matsui as sole inventor and naming Kobayashi Pharmaceutical Co., Ltd. as Applicant. On October 31, 2003, Ms. Matsui left Kobayashi Pharmaceutical. On June 21, 2004, PCT Application No. PCT/JP2004/008710 was filed, claiming priority to Japanese Patent Application No. 2003-176965. On December 20, 2005, U.S. national stage application of PCT Application No. PCT/JP2004/008710 was entered. The present application is that national stage application.

- 3. At the time of the invention, Ms. Matsui was an employee of the Assignee. Ms. Matsui executed an assignment (Exhibit A to this declaration) by which she assigned to the Assignee all of her rights in the invention, in the priority application No. 2003-176965, and in all related applications that claim such priority. A translation of the assignment is provided in Exhibit B.
- 4. On April 28, 2006, I emailed Ms. Matsui to provide her the unexecuted inventor's declaration ("the Declaration") for the above-identified application (Exhibit C). A copy of this email is attached as Exhibit D. I did not receive a response. On information and belief, two days later, Naoko Harada, a co-worker at Kobayashi Pharamceutical Co., Ltd., hand-delivered the Declaration to Ms. Matsui.
- 5. I again sent the Declaration to Ms. Matsui via registered mail on August 24, 2006; however, she refused delivery. A copy of the letter sent and the receipt of the registered mail and tracking summary are attached as Exhibit E. On August 29, 2006, I sent the Declaration to Ms. Matsui via email, again with no response. A copy of this email is attached as Exhibit F.
- 6. On information and belief, my manager Yasuyo Yamaguchi called Ms. Matsui on August 30, 2006 to ask Ms. Matsui about the outstanding Declaration and she replied that she would not sign the Declaration.
- 7. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Dated: December 7,2006

Signed: Madoka Jamashita

Name: Madoka Yamashita

# 譲渡証書

平成15年 分月20日

(譲受人)

住 所 大阪府大阪市中央区道修町四丁目3番6号名 称 / 小木木 夢と 享 卒 木 元 会 木土 代表者 小林 一雅 殿

譲渡人は、下記の発明等について、貴社の研究開発本部編「職務発明規程」における下記条項を確認し、これに基づき日本国および諸外国で特許を受ける権利、実用新案登録を受ける権利、意匠登録を受ける権利、著作権(著作権法第27条、第28条所定の権利を含む)、その他の知的財産権の全部を貴社に譲渡したことに相違ありません。

51

特許出願1.

発明の名称 : 眼科用組成物

特許出願**番号:** 2003-176965 号 特許出願日: 2003/06/20

以上、特許出願1件

(調波人) 住所又は居所大下反府落木市四中条町1-22よよしせいしか4岁301号 旺名 P公井 優香 (監)

# 【関連職務発明規程】

第2条 (用語の定義)、第3条 (権利の帰属)、第4条 (届出)、第5条 (職務発明の認定および承継の決定)、第6条 (個人出願および第三者への権利の譲渡に対する制限)、第7条 (出願手続)、第8条 (特許を受ける権利の譲渡義務)、第11条 (補償金の支払い)、第12条 (共同発明者に対する補償)、第13条 (転退職または死亡したときの補償)、第17条 (職務発明でない発明)、第18条 (嘱託および臨時雇の取扱い)、第19条 (実用新案権 意匠権に関する準用)、第20条 (外国出願の取扱い)

#### ASSIGNMENT

August. 20, 2003

(Assignee)

Address: 3-6 Doshomachi 4-chome, Chuo-ku, Osaka-shi, Osaka

Name: KOBAYASHI PHARMACEUTICAL CO., LTD

Representative: Kazumasa Kobayashi

Regarding the following invention, the assignor acknowledged the articles below of the "regulations for employee's invention" complied by the Research and Development Division of KOBAYASHI PHARMACEUTICAL CO., LTD, and hereby assigned all rights to obtain patents, all rights to obtain utility model registrations, all rights to obtain design registrations, all copyrights (including the prescribed rights pursuant to Article 27 and Article 28 of the Copyright Law), and all other intellectual property rights in Japan and elsewhere in the world to-KOBAYASHI PHARMACEUTICAL CO., LTD.

#### Note

Patent.application 1

Title of Invention: Ophthalmic composition
Patent Application Number: 2003-176965
Application Date: 06/20/2003

#### (Assignor)

Address: Angel Uchida #301, 1-22 Nishicyujo-cho, Ibaraki-shi, Osaka

Name: Yuka MATSUI [signature] [seal]

# [Regulations for Employee's Invention]

Article 2 (Definition of Terms), Article 3 (Assignation of Rights), Article 4 (Filing), Article 5 (Authorization of Employees' Inventions and Decision of Succession), Article 6 (Restriction on Individual Applications and Transfer of Rights to Third Parties), Article 7 (Application Procedures), Article 8 (Obligation for Assignation of Rights to Obtain Patents), Article 11 (Compensation Payment), Article 12 (Compensation for Co-inventors), Article 13 (Compensation for Resignation, Retirement, and Death), Article 17 (Inventions other than Employees' Inventions), Article 18 (Treatment for Employees on a Short-term or Temporary Contract), Article 19 (Application for Mutatis Mutandis to Utility Model Registrations and Design Rights), Article 20 (Foreign Applications)

# Verification of Translation

I, Kimio UEDA	of c/o ARCO PATENT	OFFICE at 3rd	Fl., Bo-e	ki Building.	123-1
-Higashi-machi,	Chuo-ku, Kobe-shi-65	0-0031 JAPAN	I, hereby	declare as fo	llows:

- 1. I am a translator and am familiar with both the Japanese and English languages.
- 2. I am the translator of the documents attached hereto and certify that the following is a true translation to the best of my knowledge and belief of the assignment.

Dated this	6th	day of	Dogganhan	0006
Dated this		day of	December	, 2006

Kimio UEDA

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name.

I believe I am an original, first and sole inventor of the subject matter which is claimed and for which a patent is sought on the invention entitled:

# OPHTHALMIC COMPOSITION

the specification of which was filed on 21 June 2004 as PCT/JP2004/008710, and assigned U.S. Patent Application Serial No. 10/561,629

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by an amendment, if any, specifically referred to herein.

I acknowledge the duty to disclose all information known to me that is material to patentability in accordance with Title 37, Code of Federal Regulations, § 1.56.

## FOREIGN PRIORITY CLAIM

I hereby claim foreign priority benefits under Title 35, United States Code § 119(a)-(d) of any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed:

	no such foreign applications have been filed		
X	such foreign application have been filed as follows:	 	

# EARLIEST FOREIGN APPLICATION(S), IF ANY FILED WITHIN 12 MONTHS (6 MONTHS FOR DESIGN) PRIOR TO THIS U.S. APPLICATION

Application Number	Country	Date of Filing (dd/mm/yyyy)	Priority Claimed Under 35 USC 119
2003-176965	Japan	20/06/2 <b>003</b>	x Yes No

# ALL FOREIGN APPLICATION(S), IF ANY FILED MORE THAN 12 MONTHS (6 MONTHS FOR DESIGN) PRIOR TO THIS U.S. APPLICATION

Application Number	Country	Date of Filing (dd/mm/yyyy)
None		

# CLAIM FOR BENEFIT OF EARLIER U.S. PROVISIONAL APPLICATIONS

I hereby claim priority benefits under Title 35, United States Code §119(e), of any United States provisional patent application(s) listed below:

# CLAIM FOR BENEFIT OF EARLIER U.S./PCT APPLICATION(S)

I hereby claim the benefit under Title 35, United States Code, §120 of the United States application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code, §112, I acknowledge the duty to disclose all information that is material to patentability in accordance with Title 37, Code of Federal Regulations, §1.56 which became available to me between the filing date of the prior application and the national or PCT international filing date of this application:

X no such U.S./PCT ap	plications	have	been file	i
الم المتعلق المنافي المعراب المعراب		-		
such U.S./PCT applie	cation hav	e been	filed as:	follows:

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

#### I hereby appoint:

All practitioners at Customer Number 04743

all of MARSHALL, GERSTEIN & BORUN LLP, 233 S. Wacker Drive, Suite 6300, Sears Tower, Chicago, Illinois 60606-6357, jointly, and each of them severally, my attorneys at law/patent agent(s), with full power of substitution, delegation and revocation, to prosecute this application, to make alterations and amendments therein, to receive the patent, and to transact all business in the U. S. Patent and Trademark Office connected therewith.

Please mail all correspondence to David A. Gass, whose address is:

# MARSHALL, GERSTEIN & BORUN LLP 233 S. Wacker Drive, Suite 6300 Sears Tower Chicago, Illinois 60606-6357

Please direct telephone calls to: David A. Gass at (312) 474-6300.

Please direct facsimiles to: (312) 474-0448

Yuka Matsui				<u> </u>	
Sole or first inventor's signan	ire :		Daic		
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lesidence -					
(baraki-shi, j	JAPAN	•			
itizenship Japanese					
Ibaraki-shi, S  Citizenship Japanese  Mailing Address  Kobayashi Phannace					



山下円 Madoka Yamashita J04231/KENKYU/KOBAYASHI 2006/04/28 11:08 宛先

CC

bcc

件名 小林製薬・山下円です。

# 優香さま

ご無沙汰しております。 小林製薬株式会社 - 知的財産G 山下です。 お元気でお過ごしでしょうか?

本日はお願いがあってメールをいたしました。 メールアドレスは原田さんに聞きました。(ずいぶん前ですが)

お願いというのは、外国出願関係の書類に署名をいただきたいのです。 とろーり目薬の特許出願を米国、カナダに出願しておりますが、 発明者の署名が必要な書類があるのです。 ゴールデンウイークにこちらにいらっしゃる旨を伺ったので、その際に ご署名をいただけませんでしょうか?(書類は御厨さんに預けさせていただきます)

どうぞよろしくお願い申し上げます。

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KENKYU01/KOBAYASHI, ZENSHA11/KOBAYASHI, ZENSHA11/KOBAYASHI, KENKYU01/KOBAYASHI

宛先: - Alexi Alegerateigen von

ec:

The second second 日付: 2006/04/28 11:08:17

件名: 小林製薬・山下円です。

優香さま

ご無沙汰しております。 小林製薬株式会社 知的財産G 山下です。 お元気でお過ごしでしょうか?

本日はお願いがあってメールをいたしました。 メールアドレスは原田さんに聞きました。(ずいぶん前ですが)

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どうぞよろしくお願い申し上げます。

2006/08/23

小林製薬株式会社 研究開発カンパニー 研究開発管理部 知的財産グループ

課長 山口 康代

〒567-0057

大阪府茨木市豊川一丁目30-3

TEL:072-640-0122 FAX:072-641-7840

E-ma i l : y.yamaguchi@kobayashi.co.jp

# 特許出願関連書類への捺印及び返送のお願い

残暑の候、貴殿におかれましてもますます御健勝のこととお慶び申し上げます。

ところで、貴殿にお願いしております、

- 1、米国特許出願 No.10/561629(基礎出願特願 2003-176965)の発明者宣誓書
- -- 2、米国特許出願 No:10/561629(基礎出願特願=2003-176965)の譲渡証----
- --3、カナダ特許出願 No.2529860(基礎出願特願 2003-176965)の譲渡証 にご署名いただく件ですが、それぞれ各国官庁への書類提出期限が迫ってまいりました。 つきましては、本年 4 月末にお渡しした書類に、必要な署名をし、同封の返信用封筒にて 上記の住所までなるべく早くご返送くださるようお願いいたします。

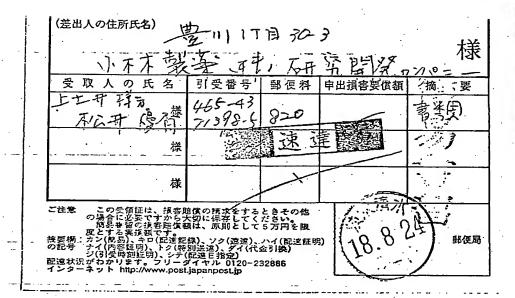
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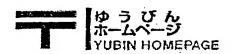
大変お忙しいところ誠に恐縮ですが、8月31日までに到着するよう、ご手配いただけたら 幸甚です。よろしくお願い申し上げます。 ----

なお、署名いただく書類の内容等について、ご不明な点等ございましたら、何なりと、上 記連絡先までご連絡ください。

末筆ながら、貴殿のこれからのご健康とご活躍をお祈り申し上げます。

敬具





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8月24日 18:50	発送	7	<u>茨木</u> 567-8799	大阪府
8月25日 0:21	発送	·	新大阪 53 <b>9-87</b> 99	大阪府
8月25日 11:0 <b>5</b>	到着		宇都宮東 321-8799	栃木県
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9月4日 0:27	発送		新大阪 53 <b>9-8</b> 79 <b>9</b>	大阪府
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動便局 郵便局サービスの

1					
	Date	Status	Details	Post office ZIP code	Prefec ture
	Aug 24 13:50	Posting/Coll ection		IBARAKI SH IMIZU 567-0059	Osaka p refectu re
	Aug 24 18:50	Dispatched a t Exchange Office		1BARAK1 567-8799	Osaka p refectu re
	Aug 25 0:21	Dispatched a t Exchange Office		SHINOSAKA 539-8799	Osaka p refectu re
	Aug 25 11:05	Processing a t delivery Post Office		UTSUNOMIYA HIGASHI 321-8799	Tochig i prefe cture
	Aug 25	Absence. Att empted deliv ery.		UTSUNOMIYA HIGASHI 321-8799	Tochig i prefe cture
2	Sер 2	Returned to Sender	Retention	UTSUNOMIYA HIGASHI 321-8799	Tochig i prefe cture
S	ep 2	Returned to Sender	Retention	UTSUNOMIYA HIGASHI 321-8799	Tochig i prefe cture
	ep 3 0:05	Dispatched a t Exchange Office		UTSUNOMIYA HIGASHI 321-8799	Tochig i prefe cture
S 0	: 27	Dispatched a t Exchange Office		SHINOSAKA 539-8799	Osaka p refectu re
S (	nn II	Processing a t delivery P ost Office		1BARAK1 567-8799	Osaka p refectu re
		Returned to sender		1BARAKI 567-8799	Osaka p refectu re

Check the local post-office (Japanese Only)



山下円 Madoka Yamashita J04231/KENKYU/KOBAYASHI 2006/08/29 13:55 宛先

CC

bcc

件名 小林製薬・山下です。

松井優香様

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ここに、内容を添付しますので、合わせてご確認ください。



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# 送信エラーレポート

件名: 未配信:

小林製薬・山下です。

原因:

mx2.HOTMAILCOM への転送エラー。SMTP Protocol Returned a Permanent Error 550 Requested action not taken: mailbox unavailable

送信エラーレポートを受信した場合には

- 送信できなかった文書を上記のユーザーに再送信するには、「再送信」ボタンをクリックするか、「アクション 再送信]を選択してください。
- 一旦この文書を再送信した後は、このエラーレポートを削除できます。
- 文書の再送信がエラーになった場合、新しいエラーレポートを受信します。
- 他の送信エラーレポートを受信していない限り、他のユーザーには正常に配信されています。

配信バス

KENKYU01/KOBAYASHI, ZENSHA11/KOBAYASHI, ZENSHA11/KOBAYASHI, KENKYU01/KOBAYASHI

宛先:

CC:

日付: 2006/08/29 13:55:43

\_\_\_件名: 小林製薬・山下です。

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山下円 Madoka Yamashita J04231/KENKYU/KOBAYASHI 2006/08/29 14:02 宛先

CC

pcc

件名 〈再送〉小林製薬・山下です。

送信エラーがあったようなので、再送いたします。 先ほどのメールは廃棄してください。

なお、このメールをご覧になりましたら、受信した旨のみで結構ですので、 こ返信くださいますようお願いします。

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